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In re Application of
GOLICZ et al
Application No.: 08/962,077
Filing Date: 14 September 1998
Attorney Docket No.: 9534
For: SHEET FEEDING APPARATUS

: DECISION ON PETITION
: UNDER 37 CFR 1.181,
: REQUEST TO WITHDRAW
: PETITION UNDER 37
: CFR 1.181 AND REQUEST
: FOR REFUND

This is in response to applicants' PETITION RELATING TO FILING DATE pursuant to 37 CFR 1.181 filed 14 September 1998, WITHDRAWAL OF PETITION RELATING TO FILING DATE (PETITION DATED SEPTEMBER 9, 1998) filed 21 September 1998, and REQUEST FOR REFUND OF PETITION FEE filed 04 June 1999.

BACKGROUND

On 01 April 1997, applicants filed international application No. PCT/US97/05320, which claims a priority date of 01 April 1996 and designated the United States. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 09 October 1997. The twenty-month deadline for entry into the national stage in the U.S. expired as of midnight of 01 December 1997.

On 31 October 1997, applicants filed in the United States Patent and Trademark Office (PTO), *inter alia*, a cover letter, a declaration and power of attorney, a small entity statement, a preliminary amendment, 8 sheets of formal drawings, and a check for \$527. The cover letter states that “[t]his application is a continuation of [PCT/US97/05320].”

On 14 July 1998, the PTO mailed a NOTICE OF INCOMPLETE APPLICATION (Form PTO-1123) indicating that a filing date had not been assigned because the specification was missing.

On 14 September 1998, applicants submitted a TRANSMITTAL OF SPECIFICATION which was accompanied by the entire PCT application for PCT No. PCT/US97/05320. This TRANSMITTAL stated that this “same document was previously transmitted to the USPTO as designated office on behalf of the International Bureau of WIPO”.

On 14 September 1998, applicants filed a PETITION RELATING TO FILING DATE pursuant to 37 CFR 1.181. The petition requested that: (1) the above mentioned application be granted a filing date of 31 October 1997 because the application was complete at that time "within the meaning of 35 USC 371"; (2) the above mentioned application be granted an effective filing date of 01 April 1997 under PCT Article 11(3), 35 USC 371, and 37 CFR 1.53(f); and (3) a refund of the petition fee because the application was complete as of 31 October 1997. The petition states that "[t]o commence the national stage, 35 USC 371(c)(2) says that a copy of the international application ought to be filed 'unless . . . already communicated by the International Bureau'."

Between 14 September 1998 and 21 September 1998, applicants received a Filing Receipt (Form PTO-103X) mailed by the PTO indicating the filing date of the above-mentioned application as 31 October 1997 and indicating that the application is a continuation of PCT/US97/05320 filed 01 April 1997.

On 21 September 1998, applicants filed a WITHDRAWAL OF PETITION RELATING TO FILING DATE (PETITION DATED SEPTEMBER 9, 1998) requesting withdrawal of the previously filed petition and a refund of the petition fee. The petition states that the Filing Receipt indicates a filing date of 31 October 1997 which is the date applicants petitioned for. This WITHDRAWAL was accompanied by a copy of the Filing Receipt.

On 04 June 1999, applicants filed a STATUS INQUIRY and a REQUEST FOR REFUND OF PETITION FEE.

On 18 June 1999, applicants filed a STATUS INQUIRY.

On 22 October 1999, applicants filed a status inquiry directed to the Supervisory Patent Examiner of Art Unit 3615.

On 25 February 2000, applicants filed a letter directed to Ms. Eugenia Jones in the Office of Petitions noting that if any papers were missing from the file of the above-mentioned application, applicants' representative could have them hand delivered.

On 01 March 2000, applicants filed a PETITION TO MAKE SPECIAL.

On 01 March 2000, applicants filed a LETTER. This LETTER noted that applicants were under the impression that various papers were missing from the file and provided duplicate copies of several of the papers previously filed.

DISCUSSION

This application has been forwarded to the PCT Legal Office for determination of compliance with 35 U.S.C. 371(c).

Any intended filing of an international application as a national stage application must clearly and unambiguously be identified as such and must satisfy all of the conditions set forth in 35 U.S.C. 371(c). The official PTO Notice published in the Official Gazette at 1077 OG 13 entitled "Minimum Requirements for Acceptance of Applications Under 35 U.S.C. 371 (the National Stage of PCT)" states, in part, the following:

The Patent and Trademark Office is continuing to receive application papers which do not clearly identify whether the papers (1) are being submitted to enter the national stage of the Patent Cooperation Treaty (PCT) under 35 U.S.C. 371 or (2) are being filed as a regular national application under 35 U.S.C. 111.

* * *

If there are any conflicting instructions as to which sections of the statute (371 or 111) is intended the application will be accepted under 35 U.S.C. 111.

In the present application, the submission filed 31 October 1997 contained no indication that the application was being submitted under 35 U.S.C. 371. The cover letter stated that the application was a *continuation* of PCT/US97/05320 indicating that applicants intended to claim benefit under 35 U.S.C. 120. Such benefit cannot be claimed in an application filed under 35 U.S.C. 371. Moreover, Section 371 of the statute was not mentioned in any of the papers filed in this application until the petition filed 14 September 1998. Accordingly, the application will be treated as filed under 35 U.S.C. 111.

The petition filed 14 September 1998 states that "[t]o commence the national stage, 35 USC 371(c)(2) says that a copy of the international application ought to be filed 'unless . . . already communicated by the International Bureau'." However, for the reasons set forth above, the present application has been treated as filed under 35 U.S.C. 111. Consequently, a specification was required on filing. 35 U.S.C. 111(a)(4) states that "[t]he filing date of an application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office." 37 CFR 1.53(b) states that the filing date of an application filed under that section "is the date on which a specification as prescribed by 35 U.S.C. 112 containing a description pursuant to § 1.71 and at least one claim pursuant to § 1.75, and any drawing required by § 1.81(a) are filed in the Patent and Trademark Office." Accordingly, the filing date of the above mentioned application is the date of receipt of the specification, 14

September 1998, rather than 31 October 1997.¹

The specification filed on 14 September 1998 meets the requirements for granting a filing date for a filing under 35 U.S.C. 111(a). However, the declaration filed 31 October 1997 is defective in that it fails to properly identify the specification to which it is directed, as required under 37 CFR 1.63(a)(2). The declaration identifies the international application, which is improper in an application filed under 35 U.S.C. 111. See MPEP § 1896.

Applicants are not entitled to claim benefit under 35 U.S.C. 120 and 365(c) of the filing date of the international application for the common subject matter, since this application (Application No. 08/962,077) and the international application (PCT/US97/05320) designating the United States were not copending on 14 September 1998. Applicants may wish to consider filing a petition to revive the international application for the purposes of establishing copendency.

As to the Request for Refund of the petition fee of \$130 paid 14 September 1999, "a mere change of purpose after the payment of money, as when a party desires to withdraw an application, an appeal, or a request for oral hearing, will not entitle a party to demand such a return." 37 CFR 1.26. Here, there is a mere change of purpose, i.e., withdrawal of the petition, after the payment of money.

CONCLUSION

The petition under 37 CFR 1.181 and the request to withdraw the petition under 37 CFR 1.181 are **DISMISSED** for the reasons set forth above.

The Request for Refund under 37 CFR 1.26 is **DISMISSED** for the reasons set forth above.

The Filing Receipt received by applicants between 14 September 1998 and 21 September 1998 is hereby **VACATED**.

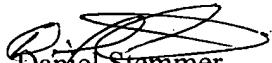
As to the Petition to Make Special filed 01 March 2000, such petitions are decided by the Special Program Examiners in the Patent Technology Centers. MPEP § 1002.02(s). The application will be forwarded to a Special Program Examiner after receipt in the appropriate Technology Center.

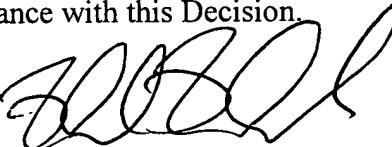
¹As noted in 37 CFR 1.8(a)(2)(i)(A), the Certificate of Mailing procedure does not apply to the filing of a patent application specification for the purpose of obtaining an application filing date. Thus, the filing date is the date of receipt (14 September 1998) in the PTO rather than the date certified in the Certificate of Mailing (09 September 1998).

If reconsideration on the merits of this petition is desired, a proper reply must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.181." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Alternatively, applicants may wish to consider filing a petition under 37 CFR 1.137 to revive the international application as being unintentionally abandoned in order to establish copendency. In this instance, applicants may either claim 35 U.S.C. 120 benefit in the above-identified application to the PCT application or may instead file another application under 35 U.S.C. 371. Such a petition should include a cover letter entitled "Petition Under 37 CFR 1.137".

The application will be forwarded to Office of Initial Patent Examination for processing as a regular national application under 35 U.S.C. 111(a) and for issuance of a new Filing Receipt with a filing date of **14 September 1998** in accordance with this Decision.


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